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10/736,675	12/17/2003	Akira Yoda	3562-0133P	4112
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EXAMINER				
KUCAB, JAMIE R				
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/736,675

**Applicant(s)**

YODA, AKIRA

**Examiner**

JAMIE KUCAB

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 3, 2009 has been entered.

### ***Acknowledgements***

2. In accordance with the RCE above, claims 1-7, 9, and 11-18 are currently pending.
3. Claims 1-7, 9, and 11-18 are examined below.
4. This Office action is given Paper No. 20090915 for reference purposes only.
5. Based on a comparison of the PGPub US 2004/0139333 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, except where otherwise noted, references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 7, 9, 11, and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Deindl et al. (6,031,910, hereinafter "Deindl") and in view of Houvener et. al. (6,070,141, hereafter "Houvener") and further in view of Rankl et al. (*Smart Card Handbook*, 2nd Edition, John Wiley & Sons, Ltd, September 18, 2000. Reference U on the attached form PTO-892. Hereafter, "Rankl").

8. Regarding claims 1 and 13, Deindl discloses an authentication processing and information storing apparatus ("patient card") performing requester authentication processing and storing thereon an owner's personal information (C2 L25 - C8 L10), comprising:

- personal information storing circuitry (file 100) storing thereon the owner's (patient's) personal information (data record 120) which is to be disclosed to a plurality of predetermined accessible persons ("a plurality of users", C2 L25-32), wherein at least one of the plurality of predetermined accessible persons is someone other than the owner (C2 L25 - C8 L10);
- access level setting circuitry ("management fields") setting an access level, which is a level of the personal information to be disclosed to the requester, when said

requester authentication circuitry authenticates the requester as the accessible person (C3 L36-54); and

- personal information output circuitry (READ/WRITE DEVICE 340 in Fig. 3) outputting a part of the personal information stored on said personal information storing circuitry to the requester in accordance with the access level set-up by said access level setting circuitry (C4 L37 - C6 L19).

9. Although Deindl discloses requester authentication circuitry ("authorization card", C6 L33-43; user card 310 in Fig. 3 and associated text) and characteristic information ("a surety", C6 L33-43; "identification feature", C6 L57- C7 L6) that may be biometric (C6 L33-43), Deindl fails to explicitly disclose:

- accessible person information storing circuitry storing thereon accessible person characteristic information indicating a physical characteristic of each of the plurality of accessible persons;
- requester authentication circuitry receiving requester characteristic information indicating a physical characteristic of a requester who requests the personal information, and for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing circuitry; and
- the apparatus further comprising image capturing circuitry for generating the requester characteristic information by capturing an image of the requester.

10. However, Houvenier teaches:

- accessible person information storing circuitry ("valid user database", col. 10 line 40) storing thereon accessible person characteristic information ("first and second ID units", col. 3 lines 55-56) indicating a physical characteristic ("retinal image", col. 9 line 20) of each of the plurality of accessible persons;
- requester authentication circuitry (point of identification terminal 1 in Fig. 1) receiving requester characteristic information indicating a physical characteristic of a requester who requests the personal information, and for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing circuitry (Fig. 6A and 6B and associated text); and
- the apparatus further comprising image capturing circuitry ("automated comparison system", col. 9 lines 17-18) for generating the requester characteristic information by capturing an image of the requester.

11. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Deindl to include the accessible person information storing circuitry, requester authentication circuitry, and image capturing circuitry of Houvener in order to achieve the predictable result of providing a secure and robust means of biometric authentication.

12. The combination of Deindl/Houvener fails to explicitly disclose wherein if a computed correlation between the requester characteristic information and the

accessible person characteristic information is greater than or equal to a predetermined reference value, the requester is authenticated as a predetermined accessible person.

13. If not inherent to Houvener, then Rankl teaches wherein if a computed correlation between the requester characteristic information and the accessible person characteristic information is greater than or equal to a predetermined reference value ("adjustable identification threshold"), the requester is authenticated as a predetermined accessible person (pp. 390-394).

14. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Deindl/Houvener to include the predetermined reference value of Rankl in order to achieve the predictable result of allowing access to the correct persons while minimizing the number of incorrect authorizations.

15. Deindl/Houvener/Rankl fails to explicitly disclose wherein at least one of the plurality of predetermined accessible persons is someone other than the owner. However, this difference is only found in the nonfunctional descriptive material and does not affect how the claimed invention functions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the combination of Deindl/Houvener/Rankl to include wherein at least one of the plurality of predetermined accessible persons is someone other than the owner, because such descriptive material does not alter how the claimed invention functions.

16. Regarding claim 7, Houvener further discloses wherein said accessible person information storing circuitry stores a plurality of accessible person characteristic information of each of the accessible persons ("first and second ID units", col. 3 lines 55-56), said requester authentication circuitry receives a plurality of requester characteristic information (steps 220 and 245 in Fig. 6A), and performs authentication processing of the requester using the plurality of accessible person characteristic information and the plurality of requester characteristic information (step 260 in Fig. 6B).

17. Regarding claim 9, Houvener further discloses wherein said requester authentication circuitry employs face information ("retinal image", col. 9 line 20) as the requester characteristic information and the accessible person characteristic information.

18. Regarding claim 11, Houvener further discloses wherein said requester authentication circuitry receives the requester characteristic information from a portable apparatus retained by the requester ("smart card", col. 10 line 29), and said personal information output circuitry outputs the personal information to the portable apparatus retained by the requester and causes the portable apparatus to store the personal information (col. 10 lines 29-30).

19. Claims 2-6, 12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deindl/Houvener/Rankl and further in view of Schneider et al. (6,105,027).

20. Regarding claims 2, 3, 14, and 15, Deindl/Houvener/Rankl disclose the claimed invention, however, Deindl/Houvener/Rankl fail to explicitly disclose the apparatus



further comprising an access level storing circuitry storing thereon a personal information level, which is a level of the personal information to be disclosed to the accessible person, and an authentication criterion, which is strictness of the authentication to be performed when the personal information within the personal information level is disclosed, in association with each other, wherein said access level setting circuitry determines the personal information level corresponding to the authentication criterion as at least a part of the access level when said requester authentication circuitry authenticates the requester by the authentication criterion.

Schneider et al. teach an access level storing circuitry (Fig. 6) storing thereon a personal information level ("Trust/Data Sensitivity Level" in Fig. 6), which is a level of the personal information to be disclosed to the accessible person, and an authentication criterion ("Minimum Encryption" in Fig. 6), which is strictness of the authentication to be performed when the personal information within the personal information level is disclosed, in association with each other, wherein said access level setting circuitry determines the personal information level corresponding to the authentication criterion as at least a part of the access level when said requester authentication circuitry authenticates the requester by the authentication criterion (col. 18 lines 6-11). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Deindl/Houvener/Rankl to include the access level storing circuitry of Schneider et al. in order to provide different levels of access to different users.

21. Regarding claims 4, 5, 16, and 17, Deindl/Houvener/Rankl disclose the claimed invention, however, Deindl/Houvener/Rankl fail to explicitly disclose wherein said access level storing circuitry stores the plurality of personal information levels and also stores a lower limit of credibility of the authentication as the authentication criterion corresponding to each of the personal information levels, said requester authentication circuitry outputs the credibility of the authentication for the requester based on the result of the comparison of the requester characteristic information with the accessible person characteristic information, and said access level setting circuitry selects the personal information level of which the lower limit of the corresponding credibility is less than the credibility of the authentication output by said requester authentication circuitry, and sets the access level to the sum of the selected personal information levels. Schneider et al. disclose an access level storing circuitry that stores the plurality of personal information levels ("Trust/Data Sensitivity Level" in Fig. 6) and also stores a lower limit of credibility of the authentication as the authentication criterion corresponding to each of the personal information levels ("Minimum Authentication" in Fig. 6), said requester authentication circuitry outputs the credibility of the authentication for the requester based on the result of the comparison of the requester characteristic information with the accessible person characteristic information (col. 19 line 55 - col. 20 line 11), and said access level setting circuitry selects the personal information level of which the lower limit of the corresponding credibility is less than the credibility of the authentication output by said requester authentication circuitry, and sets the access level to the sum of the selected personal information levels (col. 19 line 55 - col. 20 line 11). It would have

been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Deindl/Houvener/Rankl to include the access level storing circuitry of Schneider et al. in order to provide different levels of access to different users.

22. Regarding claims 6, 12, and 18, Deindl/Houvener/Rankl disclose the claimed invention, but Deindl/Houvener/Rankl fail to explicitly disclose the apparatus further comprising wherein said access level storing circuitry stores the personal information level and the authentication criterion in association with a title of the requester, said requester authentication circuitry further receives the title of the requester from a belonging of the requester, and performs authentication processing of the requester using the authentication criterion by reading the authentication criterion corresponding to the received title from said access level storing circuitry, and said access level setting circuitry sets the access level to the personal information level corresponding to the title of the requester when said requester authentication circuitry authenticates the requester as the accessible person. Schneider et al. teach an access level storing circuitry (access filter 203 in Fig. 2) that stores the personal information level and the authentication criterion in association with a title of the requester ("UserID" in Fig. 13A), said requester authentication circuitry further receives the title of the requester from a belonging of the requester ("SmartCard" in Fig. 13A), and performs authentication processing of the requester using the authentication criterion by reading the authentication criterion corresponding to the received title from said access level storing circuitry, and said access level setting circuitry sets the access level to the personal information level corresponding to the title of the requester when said

requester authentication circuitry authenticates the requester as the accessible person (col. 35 lines 4-23). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Deindl/Houvener/Rankl to include the access level storing circuitry of Schneider et al. in order to more efficiently provide information access to groups of users.

23. Claims 1, 7, 9, 11, and 13 are alternately rejected under 35 U.S.C. 103(a) as being unpatentable over Deindl/Houvener/Rankl and further in view of Examiner's Official Notice.

24. The combination Deindl/Houvener/Rankl discloses all the elements of the claimed invention. But Deindl/Houvener/Rankl fails to explicitly disclose that the information storing apparatus is retained by the owner. It is the Examiner's primary position that this is intended use language, and the Deindl/Houvener/Rankl combination is capable being retained by an owner, and, therefore, meets this limitation.

25. However, if not inherent in Deindl/Houvener/Rankl, the Examiner takes Official Notice that it is old and well known in the art to make an information storing apparatus portable such that it can be retained by the owner, because this allows individuals to eliminate redundant objects by transporting them from one location to another. It would have been obvious to a person having ordinary skill in the art at the time of the invention to make the information storing apparatus portable such that it can be retained by the owner in order to achieve the predictable result of providing the owner of information with control over the security of that information.

26. The Official Notice that making an information storing apparatus portable such that it can be retained by the owner was old and well known at the time of Applicant's invention is taken to be admitted prior art. The Official Notice was asserted by the Examiner in paragraph 11 of the Office action mailed June 29, 2007. Applicant did not properly traverse this Official Notice in Applicant's next response filed November 28, 2007. Therefore, it is taken to be admitted prior art. See MPEP 2144.03.C.

#### ***Claim Interpretation***

27. Except where expressly noted otherwise, the Examiner maintains the claim interpretations and definitions of paragraphs 26-30 of the Office action mailed January 29, 2008 (Paper No. 20080116).

#### ***Response to Arguments***

28. Applicant's arguments with respect to the objections to the drawings have been fully considered and are persuasive. First, the reference to Fig. 5 is interpreted by the Examiner as an intended reference to Fig. 6, as none of the discussed features are present in Fig. 5 and all are present in Fig. 6. Second, Applicant admits that the following features are conventional: image capturing circuitry, requester authentication circuitry, access level setting circuitry, personal information output circuitry, accessible person information storing circuitry, and personal information storing circuitry. As they are conventional, the Examiner takes the position that they are also old and well

known.<sup>1</sup> The objections to the drawings have been withdrawn in view of Applicant's admission that the corresponding limitations of Applicant's claimed invention are old and well-known in the art.

29. Applicant's arguments with respect to the objections to the specification have been fully considered and are persuasive. The objections to the specification have been withdrawn.

30. The various rejections of claims 8 and 10 are withdrawn as moot due to the claims having been cancelled.

31. Applicant's arguments with respect to the §112, 1<sup>st</sup> paragraph rejections of claims 1-7, 9, and 11-18 have been fully considered and are persuasive. These §112, 1<sup>st</sup> paragraph rejections of the previous Office action have been withdrawn.

32. Applicant's arguments with respect to the §112, 2<sup>nd</sup> paragraph rejections of claims 1-7, 9, 11, and 12 have been fully considered and are persuasive. These §112, 2<sup>nd</sup> paragraph rejections of the previous Office action have been withdrawn.

33. Applicant's arguments with respect to the §103 rejections of the claims have been fully considered but they are not persuasive. See the above rejection for a detailed mapping of the previously applied prior art to the newly added limitations. Additionally, that the information apparatus is "retained by the owner" is intended use language. As the device / computer-readable medium of Deindl/Houvener/Rankl is

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<sup>1</sup> **conventional:** 1. traditional; normal; customary. 2. conservative or unoriginal. (conventional. 2001. In *Chambers 21st Century Dictionary*. Retrieved from <http://www.credoreference.com/entry/chambdict/conventional>)

capable of being retained by someone (as is nearly any device or system), it meets this portion of the added limitations.

### ***Conclusion***

34. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

35. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

36. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

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